

## REMARKS

### Response to Restriction Requirement/Election

Responsive to the Restriction Requirement, Applicants hereby confirm their telephonic election without traverse of the claims of Group I (i.e., claims 1-14) directed to sample analyzers.

### Claim Rejections – 35 U.S.C. § 112, Second Paragraph

The rejection of claims 2-6, 11, and 13 under 35 U.S.C. § 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention is respectfully traversed.

For the record, Applicants respectfully submit that the claim language fully conforms to the parameters of MPEP 2173.01, which states:

Applicant may use functional language...or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. [emphases added]

Furthermore, Applicants respectfully submit that the claim language fully conforms to the parameters of MPEP 2173.05(g), which states:

There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

For at least the reasons set forth above, Applicants respectfully submit that the claim language is not indefinite. Accordingly, withdrawal of this ground of rejection is respectfully requested.

### Claim Rejections – 35 U.S.C. § 102

The rejection of claims 1-14 under 35 U.S.C. § 102(b) as being anticipated by *Chupp et al.* (U.S. Patent No. 5,631,165) is respectfully traversed.

*Chupp et al.* describes a method for performing automated hematology and cytometry analysis; however, *Chupp et al.* fails to teach, either expressly or inherently, each and every element recited in rejected independent claims 1 and 10. At a minimum, *Chupp et al.* contains no teaching or suggestion of "an acidic solution," as required by each of independent claims 1 and 10. Moreover, *Chupp et al.* contains no teaching or suggestion of "a sample preparation unit configured for...diluting [a] sample supplied by [a] pipette with an acidic solution," as required by independent claim 1 or any teaching or suggestion of "a pipette washing unit configured for washing [a] pipette with an acidic solution," as required by each of independent claims 1 and 10 (emphases added).

In response to the argument advanced in the Office Action (page 4, second paragraph) that the "acidic solution" recited in independent claims 1 and 10 cannot be accorded any patentable weight—presumably because this recitation is regarded as functional language—Applicants respectfully draw attention to the above-cited sections of the MPEP sanctioning the use of functional language as well as to the mandates of MPEP 2173.05(g), which states:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element...to define a particular capability or purpose that is served by the recited element....

Inasmuch as *Chupp et al.* contains no teaching or suggestion of "an acidic solution"—much less any teaching or suggestion of a "sample preparation unit" as recited in independent claim 1 or a "pipette washing unit" as recited in independent claims 1 and 10, Applicants respectfully submit that the claimed invention is neither anticipated by nor would have been obvious in view of this reference. Accordingly, withdrawal of this ground of rejection is respectfully requested.

#### New Claim

New claim 25 recites "a sample preparation unit configured for...diluting [a] urine sample supplied by [a] pipette with an acidic dilution solution" and "a pipette washing unit configured for washing the pipette with an acidic solution." Inasmuch as *Chupp et*

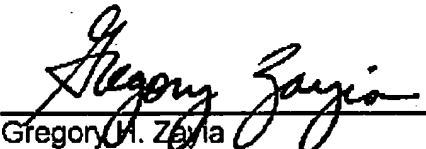
al. contains no teaching or suggestion of any acidic solution in the sense of the claimed invention, as noted above, Applicants respectfully submit that new claim 25 is patentable for at least the same reasons set forth in the remarks above.

**Conclusion**

In view of the Remarks set forth above, Applicants respectfully submit that the claimed invention is in condition for allowance. Early notification to such effect is earnestly solicited.

If for any reason the Examiner feels that the above Remarks do not put the claims in condition to be allowed, and that a discussion would be helpful to advance prosecution, it is respectfully requested that the Examiner contact the undersigned agent directly at (312)-321-4257.

Respectfully submitted,

  
\_\_\_\_\_  
Gregory M. Zayia  
Registration No. 48,059  
Agent for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200